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REMARKS

This is a full and timely response to the final Official Action mailed February 24, 2006. Reconsideration of the application in light of the following remarks is respectfully requested.

Claim Status:

No amendments are made by the present paper. Claims 16-27 were withdrawn under a previous restriction requirement and cancelled without prejudice or disclaimer. Thus, claims 1-15, and 28-32 are currently pending for further action.

Drawings:

The recent Office Action objected to the drawings under 37 C.F.R. § 1.84(p)(5) on the grounds that the "handwritten writings" recited in the claims must be illustrated. Applicant respectfully traverses this objection.

Applicant notes that the claims are method claims. Consequently, the claims recite a method of storing handwritten writings and do not recite the writings per se. The drawings do illustrate the claimed "furniture [that] comprises a member comprising a surface of a material used to construct said furniture that is configured to permanently receive said handwritten writings." Applicant respectfully submits that this is sufficient under 37 C.F.R. § 1.84(p)(5) and requests that the objection to the drawings be withdrawn.

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35 U.S.C. § 112, Second Paragraph:

The Office Action rejected claim 12 under 35 U.S.C. § 112, second paragraph, because, according to the Action, "it is unclear how carving, wood burning, etching, brush marks, imprints and stamps can be considered handwritten writings." (Action of 2/24/06, p. 3). Applicant respectfully disagrees. In carving, wood burning, etching, etc. a human uses an instrument, such as a knife, wood burner, etc., to produce writing. This writing is thus handwritten in the same sense as if the writer were holding a pen or pencil. On this point, Applicant's specification expressly states that: "Writings may be made, for example, with any one or more of the following: pencil, pen, marker, paintbrush, woodburning tool, carving tool, etching tool, brush, imprint, stamp, etc." (Applicant's specification, paragraph 0017). Consequently, claim 12 is thought to be clear and consistent with the other claims. Thus, the rejection of claim 12 under § 112, second paragraph, should be reconsidered and withdrawn.

Prior Art:

With regard to the prior art, claims 1-14 and 28-32 were rejected under 35 U.S.C. § 103(a) over the teachings of U.S. Patent No. 1,569,486 to Hardin ("Hardin") taken alone. In an alternative rejection, claims 1-5, 8-15 and 28-32 were rejected under 35 U.S.C. § 103(a) over the teachings of U.S. Patent No. 6,735,831 to Greiwe et al. ("Greiwe"). In still another alternative rejection, claims 1-3, 6-11, 28 and 30-32 were rejected under 35 U.S.C. § 103(a) over the teachings of U.S. Patent No. 668,582 to McClintock ("McClintock"). For at least the following reasons, these rejections are all respectfully traversed.

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Applicant's specification describes "a method and system for storing and preserving writings and memoranda to enhance the value of an heirloom. The writings and memoranda may be stored and preserved in a variety of methods. In one embodiment, the writings will be stored in and/or on a piece of furniture specifically designed for storing such writings." (Applicant's specification, paragraph 0017). In the embodiment claimed, the writings are made directly on a surface of the furniture specifically intended for that purpose. As stated in Applicant's specification, "the writing surface may be any type of wood, plastic, metal, ceramic, marble or other material, which may be marked." (*Id.*). "More specifically, the writings may be stored on planks, tablets or drawers built into, on or attached to (e.g., hinged to) the piece of furniture." (Applicant's specification, paragraph 0018).

This concept appears expressly in Applicant's claim 1. Claim 1 recites: "A method for storing handwritten writings, said method comprising storing said handwritten writings on a piece of furniture, wherein said furniture comprises *a member comprising a surface of a material used to construct said furniture that is configured to permanently receive said handwritten writings.*" (emphasis added). Thus, claim 1 expressly recites that the surface receiving the handwritten writings is of "a material used to construct the furniture," e.g. wood, plastic metal, etc.

In contrast, the three prior art references cited generally do not teach or suggest the claimed method in which a surface of a material that is used to construct a piece of furniture is configured to permanently receive handwritten writings. Rather, the prior art references cited either do not teach or suggest handwritten writings or merely teach temporarily securing a piece of paper that may bear handwriting to some furniture-like structure.

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For example, Hardin teaches a desk in which sheets of paper may be kept under a transparent plate. According to Hardin, “the sheets bearing the memoranda, data, or other subject-matter are placed between the mat and glass plate for inspection through the transparent plate.” (Hardin, lines 82-87). Hardin does not teach or suggest the claimed method in which handwritten writings are stored on a surface of a material used to construct a piece of furniture that is configured to permanently receive such writings.

Griewe teaches a “cremation remains container” that includes a memorial plaque (70). However, the plaque taught by Griewe is not “handwritten.” Griewe does not teach or suggest that the plaque can be handwritten. One of skill in the art would not conclude that the plaque taught by Griewe is handwritten. To the contrary, viewing the illustrations provided by Griewe, the plaque (70) is clearly *not* handwritten. Thus, Griewe does not teach or suggest the claimed method of storing handwritten writings with furniture having a surface configured to permanently receive handwritten writings. There is no teaching or suggestion in Griewe of a surface specifically configured to permanently receive *handwritten* writings as claimed.

Lastly, McClintock does not teach or suggest the claimed method for storing handwritten writings on a piece of furniture, where the furniture comprises “*a member comprising a surface of a material used to construct said furniture that is configured to permanently receive said handwritten writings.*” Rather, McClintock, merely teaches a “tablet file case” in which “file drawers” (4) include fasteners (17) that are used to secure papers including “different printed forms” in the file drawer (4). (McClintock, page 2, lines 1-17).

Thus, McClintock, similar to Hardin, merely teaches a method of securing printed paper forms to structure, in this case a file drawer. McClintock does not teach or suggest the claimed

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method of "storing handwritten writings, said method comprising storing said handwritten writings on a piece of furniture, wherein said furniture comprises *a member comprising a surface of a material used to construct said furniture that is configured to permanently receive said handwritten writings.*" (emphasis added).

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). For at least these reasons, the rejections based on Hardin, Greiwe and McClintock should be reconsidered and withdrawn.

In making the foregoing rejections under § 103, the Office appears to assume subject matter or read teachings into the prior art that are not actually there. To the extent that the Office is attempting in these instances to take "official notice," Applicant invokes Applicant's right to request that prior art supporting the official notice be made of record.

"The examiner may take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art. *In re Ahlert*, 424 F. 2d 1088, 165 USPQ 418, 420 (CCPA 1970). . . . If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position." M.P.E.P § 2144.03.

Specifically, Applicant requests that the Office cite prior art that shows actual *handwritten* writings on a surface of a material used to construct a piece of furniture (claim 1).

Applicant requests that the Office cite prior art showing markings on a surface of a material used to construct a piece of furniture that are to facilitate the placement of handwritten writing (claim 2). Applicant requests that the Office cite prior art teaching that such markings are grooves (claim 14).

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Applicant requests that the Office cite prior art actually teaching handwritten writings on a drawer (claim 6) of a piece of furniture, rather than merely on paper attached to a drawer.

Applicant requests that the Office cite prior art teaching a handwritten *signature* on a surface of a material used to construct a piece of furniture (claim 10). None of the cited prior art references even mention a signature.

Applicant requests that the Office cite prior art actually teaching materials presented with furniture at the time of sale that designate a member of the furniture are being intended to receive the handwritten writings (claim 28). No such teachings has been indicated in the prior art. *In fact, the recent final Office Action does not appear to even attempt to address the subject matter of claim 28.*

Applicant request that the Office cite prior art actually teaching a genealogical form on a surface of a material used to construct a piece of furniture (claim 30). No such subject matter has been indicated in the prior art.

The Office has failed to cited prior art actually teachings any of these features of the claims. Consequently, these various claims should currently be held as patentable over the prior art presently of record.

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Conclusion:

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper that have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,


DATE: April 24, 2006

  
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**CERTIFICATE OF TRANSMISSION**

I hereby certify that this correspondence is being transmitted to the Patent and Trademark Office facsimile number 571-273-8300 on April 24, 2006. Number of Pages: 16

  
Rebecca R. Schow